

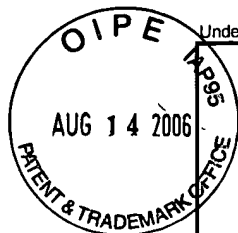
AF 80

PTO/SB/21 (09-04)

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | | Application Number | 09/688501 |
| | | Filing Date | October 16, 2000 |
| | | First Named Inventor | Shridhar P. Joshi |
| | | Art Unit | 3714 |
| | | Examiner Name | A. P. Rada |
| Total Number of Pages in This Submission | 6 | Attorney Docket Number | 47079-00077USPT |

ENCLOSURES (Check all that apply)

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| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Certificate of mailing Postcard |
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| | | | |
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| Firm Name | JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION | | |
| Signature | | | |
| Printed name | Daniel G. Nguyen | | |
| Date | August 11, 2006 | Reg. No. | 42,933 |



Docket No.: 47079-00077USPT
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Shridhar P. Joshi

Application No.: 09/688501

Confirmation No.: 3225

Filed: October 16, 2000

Art Unit: 3714

For: METHOD OF TRANSFERRING GAMING
DATA ON A GLOBAL COMPUTER
NETWORK

Examiner: A. P. Rada

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice of Non-Compliant Appeal Brief dated July 11, 2006, please reconsider Appellant's currently pending appeal brief in view of the remarks herein.

Appellant's appeal brief filed May 8, 2006, was deemed by the Examiner to be non-compliant under 37 CFR § 41.37(c)(1)(vii) (the "Arguments Section"). The Examiner explained the reason for the notice of non-compliance as follows:

For a single ground of rejection, Appellant is required to argue all the claims together or, if Appellant wishes to argue some claims separately, Appellant must show why the claims are separately patentable. Merely arguing that the claims contain additional limitations is not considered a valid showing of separate patentability. Appellant has argued claims separately without showing why they are separately patentable. Therefore the appeal brief is improper.

Notice of Non-Compliant Appeal Brief dated July 11, 2006, p. 2.

During a telephone conference on July 25, 2006, the Examiner clarified that Section VII, Item D on page 18 of the appeal brief is non-compliant because it argues one or more dependent

claims without showing how those dependent claims are separately patentable over their respective independent claims. The Examiner explained that while Appellant had made a showing of separate patentability over the prior art, Appellant had failed to show why the dependent claims were “separately patentable” over the independent claims.

In a follow-up telephone conference on August 8, 2006, the Examiner reiterated his position that arguments directed separately to one or more dependent claims must show how those dependent claims are separately patentable over both the prior art and the independent claims. The Examiner further stated during the second telephone conference that a showing of separate patentability over the independent claims would necessarily provoke a Restriction Requirement for the argued dependent claims. In other words, Appellant’s options were to (i) withdraw all arguments on the separate patentability of any dependent claims, or (ii) argue in a manner that would cause the Examiner to issue a Restriction Requirement. When asked, however, the Examiner stated he was not aware of any authority for his position, only that this is what he “has always been told.”

Appellant is very grateful for the courtesy of the two telephone conferences, but must respectfully disagree with the Examiner’s position for the following reasons: (1) it is inconsistent with the opening premise of the Arguments Section of 37 CFR § 41.37, (2) it is unreasonable in view of the provision of the Arguments Section permitting claims to be argued separately, and (3) it is contrary to the opinions of personnel at the Board of Patent Appeals and Interferences and the Office of Patent Legal Administration.

1. The Examiner’s position is inconsistent with the opening premise of 37 CFR § 41.37(c)(1)(vii)

The first sentence of the Arguments Section (reproduced below) requires Appellants to state their contentions with respect to each ground of rejection. As the Examiner is aware, the grounds of rejection at issue on appeal are based entirely on the prior art. Therefore, in accordance with the first sentence of the Arguments Section, Appellant should be required to make a showing of separate patentability only with respect to the prior art. Appellant respectfully submits that requiring Appellant to also make a showing of separate patentability over the independent claims is inconsistent with the Arguments Section’s opening premise.

The contentions of Appellant with respect to each **ground of rejection** presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, **the claims may be argued separately or as a group**. When multiple claims subject to the same ground of rejection are argued as a group by Appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of Appellant to separately argue claims which Appellant has grouped together shall **constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately**. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

37 CFR § 41.37(c)(1)(vii) (*emphasis added*).

2. *The Examiner's position is unreasonable in view of the provision of the Arguments Section permitting claims to be argued separately*

In addition, the fourth sentence of the Arguments Section (highlighted above) allows claims to be argued as a group or separately for each ground of rejection. Indeed, failure to separately argue a claim constitutes a **waiver** of arguments with respect to that claim. Thus, the Arguments Section clearly contemplates and even encourages Appellants to argue claims separately. However, if the Examiner's approach were followed, such a strategy would result in a Restriction Requirement because Appellant would be required to show separate patentability over the independent claims in the arguments. A Restriction Requirement is clearly not an outcome that the Arguments Section intended at this advance stage of the prosecution and moreover would be **unfair** to Appellant given the numerous opportunities the Examiner has already had to raise such a Restriction Requirement. Accordingly, Appellant respectfully submits that the Examiner's position is unreasonable in view of the provision of the Arguments Section permitting claims to be argued separately.

3. *The Examiner's position contradicts the opinions of personnel at the Board of Patent Appeals and Interferences and the Office of Patent Legal Administration*


On August 11, 2006, in an attempt to obtain further guidance, Appellant separately solicited second opinions from Examiner Dale Shaw at the Board of Patent Appeals and Interferences and Attorney Robert Spar in the Office of Patent Legal Administration. After hearing Appellant's explanation as outlined above, both Examiner Shaw and Attorney Spar expressed the opinion that the Arguments Section did not require a showing of separate patentability over the independent claims for dependent claims that are argued separately. Appellant therefore respectfully submits that the Examiner's position is contrary to the opinions of personnel at the Board of Patent Appeals and Interferences and the Office of Patent Legal Administration.

CONCLUSION

In view of the above remarks, Appellant believes the currently pending appeal brief is in compliance with all provisions of 37 CFR § 41.37 and withdrawal of the Notice of Non-Compliant Appeal Brief is respectfully requested.

Dated: August 11, 2006

Respectfully submitted,

By 

Daniel G. Nguyen

Registration No.: 42,933

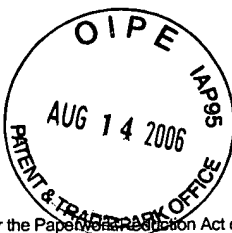
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Application No. (if known): 09/688501

Attorney Docket No.: 47079-00077USPT

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on August 11, 2006
Date


Signature

Daniel G. Nguyen

Typed or printed name of person signing Certificate

42,933

Registration Number, if applicable

(713) 951-3354

Telephone Number

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Response to Notice of Non-Compliant Appeal Brief (4 pages)
Transmittal (1 page)
Postcard (1 page)